

7-11-03 11:03 AM 003

REMARKS/ARGUMENTS

As suggested by the examiner, the title has been amended to further clarify the nature of the instant application.

Claim 20 was rejected under 37 CFR 1.75(c) as being in improper dependent form for failing to further limit the subject matter of a previous. Examiner correctly alludes to the possibility that dependency on claim 14 was intended. Applicant corrects this typo accordingly.

Claims 1-3 and 6-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner states that a key feature of the disclosed invention is isolating one strand of a double-stranded target nucleic acid, and notes that no such isolation occurs in the embodiments of claims 1,2, or 26. Examiner submits that the further limitation of claim 4, which adds steps of "dissociating the heteroduplex and isolating the first strand" is essential subject matter in understanding the method of claims 1 and 2 insofar as the heteroduplex embodiment is concerned. Similarly, Examiner submits that such steps are required in claim 25 in order to understand it to be a method of "isolating one strand of a double-stranded target nucleic acid." Applicants amend claims 1 and 2 and 25, cancel claims 3-5, as well as add claims 27 and 28. Further, these amendments and newly added claims are not performed for reasons related to patentability, do not add new matter, and are believed to render Examiner's rejection moot. Reconsideration is respectfully requested.

Further, applicants amend claims 6, 7, 8, 9, 14, 21, 22, 23, and 24 to reflect their dependency on newly added claims 27 and 28. Further, for the purposes of better clarifying antecedent basis, applicants amend claim 17.

Applicants thank the Examiner for helpful comments regarding stated closest prior art. No new matter is introduced by any of these amendments.

Applicants respectfully request reconsideration in view of the foregoing amendments and remarks.

FEE AUTHORIZATION and REQUEST FOR TIME EXTENSION

A Petition for a 3-Month Extension of Time is enclosed herewith. If any additional time extensions are required, such time extensions are hereby requested. If any additional fees not

Appl. No. 09/909,001
Amendment dated December 19, 2003
Reply to Office Action of June 19, 2003

submitted with this response are required, please take such fees from Applied Biosystems
Deposit Account No. 01-2213 (Order No. 4543).

Respectfully submitted,

Date: 12/19/03

Andrew R Finn

Andrew K. Finn
Agent for Applicants
Reg. No. 54, 097
Telephone: 650-554-3392
Customer No.: 22896